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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,732	01/18/2000	Eric G. Suder	16312-P003D1	1037

7590 09/27/2002

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EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 09/27/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/484,732	SUDER ET AL.	
	Examiner	Art Unit	
	Ming Chow	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 40-59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 40, 43, 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "typical" on Line 15 Page 40 is not clearly defined.
2. Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "retrieving the message to a second caller ID" on Line 7 Page 43 is confusing and cannot reasonably convey to one skilled in the relevant art.
3. Claims 55, 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "non-typical" on Lines 2, 3, Page 45 is not clearly defined.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same

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invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 44, 54 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,067,349. This is a double patenting rejection.

5. Claim 46 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of prior U.S. Patent No. 6,252,944. This is a double patenting rejection.

6. Claim 47 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,252,944. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 40, 41-43, 45, 48, 50-53, 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US-PAT-NO: 5,970,128).

For claims 40, 49, 50, 55, regarding circuitry adaptable for coupling the system to an analog telephone extension, wherein the analog telephone extension includes a display operable for displaying alphanumeric information, and wherein the analog telephone extension includes a first caller ID modem, Kim teaches on Column 2 Line 6 "FIG. 3 is a block diagram showing an example of an analog telephone set". Kim also teaches on Column 4 Line 38 the telephone (or adjust box) demodulates the FSK signal and displays the caller's number and/or name on an LCD. The LCD of Kim is the claimed "display". The "adjust box" of Kim is the claimed "first caller ID modem". It is inherent that there must be a circuitry for coupling the system to an analog telephone extension. Regarding circuitry for creating and storing a message associated with the analog telephone extension, Kim teaches on Column 1 Line 53 the CID data is transmitted to a called subscriber. The "CID data" of Kim is the claimed "message". It is inherent that there must be a circuitry for creating and storing a message. Regarding a second caller ID modem coupled to the circuitry adaptable for coupling the system to the analog telephone extension, Kim teaches on Column 2 Line 1 SPCS has detected the acknowledgement

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signal ACK, it transmits the CID data to the CPE via 1200 baud Bell 202 format FSK signal. It is inherent that there must be a second caller ID modem (on the SPCS) to transmit the CID data.

Regarding circuitry for retrieving the message from the storing circuitry to the second caller ID modem, Kim teaches on Column 1 Line 14 SPCSs to deliver information such as the caller's telephone number and/or name to a telephone set. It is inherent that there must be a circuitry for retrieving the message (CID data of Kim) from the storing circuitry to the second caller ID modem (before the message is transmitted to the telephone set). Regarding circuitry for sending the message from the second caller ID modem to the first caller ID modem, Kim teaches on Column 1 Line 14 SPCSs to deliver information. It is inherent that there must be a circuitry to send the message from the second caller ID modem to the first caller ID modem. Regarding circuitry for displaying the message on the display, wherein the message does not include typical caller ID information, Kim teaches on Column 4 Line 52 the data packet contains the CID information on telephone number, name, month, date, hour, minute, etc. The "month, date, hour, minute" of Kim are not typical caller ID information.

Regarding claims 41, 51, 59, Kim teach on Fig. 2B "ACK". The "ACK" (acknowledgement) of Kim is the claimed "response to receipt of an incoming call".

Regarding claims 42, 52, Kim teaches on Fig. 2A the "caller identity data" (the claimed "message") is sent to the first caller ID modem (item 10 of Fig. 2A) between "Ring#1" and "Ring#2" (the claimed "while the analog telephone extension is being rung").

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Regarding claims 43, 53, 56, Kim teaches on Column 1 Line 12 caller identification (CID) service ... to deliver information such as the caller's telephone number and/or name. The "name" of Kim is the claimed "an identity".

For claim 45, regarding switching circuitry adaptable for receiving the incoming call, wherein the switching circuitry is adaptable for connecting the incoming call to the analog telephone extension, Kim teaches on Column 1 Line 13 stored program controlled switching system. It is inherent that the switching system must receive the incoming call and connect to the telephone extension (analog telephone of Kim). Regarding voice processing circuitry adaptable for automatically interacting with the incoming call, wherein the switching circuitry and the voice processing circuitry are controlled by a single processing means in the system, it is inherent that the (voice) switching system must have a voice processing circuitry interacting with the incoming call. It is inherent that the switching circuitry and the voice processing circuitry (both of the switching system) are controlled by a single processing means ("stored program" of Kim).

Regarding claim 48, Kim teaches on Column 1 Line 13 stored program controlled switching system. The "stored program" of Kim is the claimed "a single set of software".

For claim 57, regarding receiving the non-typical caller ID message by the first caller ID modem. Kim teaches on Column 4 Line 52 the data packet contains the CID information on telephone number, name, month, date, hour, minute. The "month, date, hour, minute" of Kim are the claimed "non-typical caller ID message". It is inherent that there must be a caller ID modem (the

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claimed first caller ID modem) on the switch for sending the caller ID information. Regarding in the first caller ID modem, converting the message into tones. Kim teaches on Column 4 Line 20 an analog-to-digital (A/D) converter commonly connected to the CPE alert detecting circuit. It is inherent that the first caller ID modem must convert the message into tones before it is transmitted to the A/D converter on CPE. Regarding transmitting the tones to the second caller ID modem; and in the second caller ID modem, converting the tones back into the message. Kim teaches on item 60 Fig. 4 A/D converter (to convert tones back into the message for display).

Regarding claim 58, Kim teaches on item 10 Fig. 2B a telephone with a display. The caller identity data is transmitted from SPCS to the CPE for display.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Terschluse (US-PAT-NO: 6,118,857) teach modem.

9. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703)

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305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

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Ming Chow

(w)

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

